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			EXAMINER	
			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/029,159

Applicant(s)

DEEDS ET AL.

Examiner

Firmin Backer

Art Unit

3621

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-27 and 33-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-27 and 33-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

*Response to Amendment*

This is in response to an amendment file on August 22<sup>th</sup>, 2004. In the amendment, claims 21, 22, 26-27, 33 and 35 have been amended, claims 28-32 have been canceled, and claims 36-42 have been added. Claims 21-27 and 33-42 are pending in the letter.

*Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 21, 22, 36 and 39 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

In the present case the inventive concept in claims 21, 22, 36 and 39 only recites an abstract idea. The recited do not apply, involve, use or advance the technological arts since all

the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma* (CCPA 197 USPQ 852 (1978)).

Although the recited method produces a useful, concrete and tangible result, since the claimed invention, as a whole, it not within the technological arts as explained above, claims 21, 22, 36 and 39 seemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 21-27 and 33-42 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shin et al (U.S. PG Pub No. 2002/0010698).

5. As per claim 21, 36, 37, Shin et al teach a method for providing selected content (*locking server 20 in network/mobile device, 41 Fig 2A, 4*) (*see fig 2A, 2B, 4, paragraphs 0010, 0011, 0022, 0023*), said method comprising receiving an indication of selected content presenting at least a first locking requirement associated with the selected content (*see paragraphs 0024, 0025, 0029*), the indication of selection of which is received during said operation of receiving;

and providing the selected content to the wireless mobile device together with the at least the first locking requirement to permit the selected content to be operated upon pursuant to at least a selected one of the at least the first locking requirement (*see fig 2A, 2B, 4, paragraphs 0010, 0011, 0022, 0023*).

6. As per claim 22, 39, Shin et al teach a method at a wireless device for providing selected content comprising transmitting an indication of selection of which of the plurality of content is form the selected content receiving a first locking requirement associated with the selected content selecting the acceptance of the first selected locking requirement and receiving the selected content and storing the selected content and operating upon the selected content in accordance with the selected one of the at least the first locking requirement (*see fig 2A, 2B, 4, paragraphs 0010, 0011, 0022, 0023*).

7. As per claim 23, Shin et al teach a method further comprising the operation, at the wireless mobile device, of determining when the selected one of the first locking requirement is met (*see fig 2A, 2B, 4, paragraphs 0010, 0011, 0022, 0023*).

8. As per claim 24, 40, Shin et al teach a method further comprising the operation subsequent to said operation of determining of unlocking the selected content data to release the selected content out of the selected one of the at least the first locking requirement (*see paragraphs 0024, 0025, 0029*).

9. As per claim 25, Shin et al teach a method further comprising the operation of notifying the network-based device of determination made during said operation of determining that the selected one of the first locking requirement is met (*see fig 2A, 2B, 4, paragraphs 0010, 0011, 0022, 0023*).
10. As per claim 26, Shin et al teach a method further comprising the operation of dispensing a reward to a user associated with the wireless mobile device subsequent to notifying the network based device during said operation of determining (*see fig 2A, 2B, 4, paragraphs 0010, 0011, 0022, 0023*).
11. As per claim 27, Shin et al teach a method wherein said operations of presenting and selectably providing are performed by sending a message from the network-based device that contains both the selected content and the at least the first locking requirement (*see fig 2A, 2B, 4, paragraphs 0010, 0011, 0022, 0023*).
12. As per claim 33, Shin et al teach a method wherein the selected content of the plurality of content comprises advertising content and wherein said method further comprises the operation of displaying the advertising content at the wireless mobile device according to the at least the first locking requirement (*see fig 2A, 2B, 4, paragraphs 0010, 0011, 0022, 0023*).

13. As per claim 34, Shin et al teach a method wherein the at least the first locking requirement comprises a manner by which to display the advertising content in human perceptible form (*see paragraphs 0024, 0025, 0029*).

14. As per claim 35, 42, Shin et al teach a wireless mobile device operable in a radio communication system, an improvement of apparatus for operating upon selected content selected from a plurality of content stored at a network-based device and delivered to the wireless mobile device, said apparatus comprising a content manager embodied at the wireless mobile device, said content manager for managing the selected content once delivered to the wireless mobile device, management of the selected content provided by said content manager comprising selectably locking the selected content pursuant to a locking requirement, determining when the locking requirement is met, and unlocking the selected content when the locking requirement is determined to have been met (*see fig 2A, 2B, 4, paragraphs 0010, 0011, 0022, 0023*).

15. As per claims 38 and 41, Shin et al teach a method further providing an indication of a reward (*see fig 2A, 2B, 4, paragraphs 0010, 0011, 0022, 0023*).

### ***Response to Arguments***

16. Applicant's arguments filed April 16<sup>th</sup>, 2004 have been fully considered but they are not persuasive.

*a.* Applicant argues that the prior art fail to teach an inventive concept that make use of a locking requirement to lock in content data in a user device, neither does Shin et. al. disclose use of a lock requirement for content to be locked in the user device for a specified period of time or a specified amount of usage. Applicant further argue by highlighting some significant differences in the use of the term and/or concept locking requirement and clocking option in the instant application, and the term and/concept unlocking function and locking condition in the Shin et al. reference. Examiner respectfully disagrees with Applicant characterization of the prior art. Shin et al teach a method of applying locking function to an electronic document over the Internet through a locking management server having a locked document storage means in which a locked document comprised of locking function selection region, a locking condition region, a locking guide message region, a hierarchy information region and an electronic document region, is stored, and a plain document storage means in which a plain electronic document is stored. Shin et al's inventive concept comprises preparing an electronic document and storing hierarchy information, determining whether locking function is applied to the electronic document or not, enabling a locking condition and a locking guide message to be input if the locking function is selected, storing the electronic document in the locking document storage means if the locking function is selected, if not selected, storing the electronic document in the plain document storage means, and reading the electronic document to determine whether the electronic document to be read by the reader is locked or not, transmitting the electronic document to be read if not locked, enabling to input the locking condition if locked, allowing the reader to read the



locked document if the locking condition is satisfied, and displaying the locking guide message if the locking condition is not satisfied. Furthermore Shin et al teach a structure of a locked document according to the present invention, including a locking function selection region 200, a locking condition region 201, a locking guide message region 202, a hierarchy information region 203, and an electronic document region 204. The locking function selection region 200 stores the information whether locking function is applied to the attached electronic document. For example, if the locking function selection region 200 is represented by 0, it implies that locking function is not applied to the document. If the locking function selection region 200 is represented by 1, it implies that locking function is applied thereto. Various conditions for locking the attached electronic document can be stored in the locking condition region 201. For example, the date on which the attached electronic document can be open, the specified reader or questions for quiz can be provided. That is to say, if the date on which the attached electronic document can be open is set, e.g., 10:30 am Oct. 5, 2000 (dd-mo-yr), the attached electronic document cannot be open before the date. If the reader is specified, e.g., name, resident number, address, or the school from one graduated, the one other than the specified reader can not open the attached electronic document. If questions for quiz are suggested, a predetermined quiz and the answer thereto, e.g., question "1+1" and answer "2", are stored in the locking condition region 201. The attached document can only be seen on condition that the correct answer is provided. If more than one locking methods are selected, locking conditions corresponding thereto can be stored successively. The locking guide message region 202 is a region necessary for presenting a guide message to

anyone who does not satisfy the locking condition specified by the drafter. For example, if the reading commencement date has not been reached, a guide message saying "please wait." is presented with the remaining time. If one who is not the specified reader tries to read the electronic document, a guide message saying "You are not the right person." is presented. If the answer to the quiz is wrong, a guide message saying "Incorrect." is presented. In the hierarchy information region 203, the name of a drafter (or sender) who has prepared the locked document is stored. That is to say, the name (or ID) of the drafter who has prepared the locked document first is recorded in the hierarchy information region 203. In the case when a reader who has read the locked document makes a reply to the locked document, the name of the reader is added after the drafter's name stored in the hierarchy information region 203. Likewise, names of readers who add more contents to the original document are stored in the hierarchy information region 203 (*see paragraphs 0023*).

### *Conclusion*

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

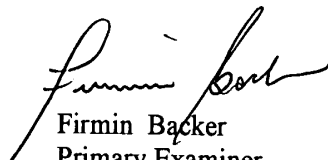
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Firmin Backer  
Primary Examiner  
Art Unit 3621

November 30, 2004